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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/573,176	03/23/2006	Wolfgang Staehle	MERCK3155	6633
23599 7590 09/21/2011 MILLEN, WHITE, ZELANO & BRANIGAN, P.C. 2200 CLARENDON BLVD. SUITE 1400 ARLINGTON, VA 22201			EXAMINER OTTON, ALICIA L	
			ART UNIT 1626	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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In re Application of :  
Staehle et al :Decision on Petition  
Serial No.: 10/573,176 :  
Filed: 23 March 2006 (national phase) :  
Attorney Docket No.: MERCK3155 :

This letter is in response to the Petition under 37 C.F.R. 1.181 filed on 9 December 2010 requesting reconsideration of the restriction requirement mailed 9 December 2008. The delay in acting up this petition is regretted.

## **BACKGROUND**

This application was filed as a national application under 35 U.S.C. 371 and as such will be considered for unity of invention practice under Chapter 1800.

On 9 December 2008, the examiner set forth a first restriction requirement which divided claims 1-29 into four groups and required a further election of species.

On 16 January 2009, applicants elected Group I and the compound where Y is phenyl or pyridyl, and the species of example 3, with traverse.

On 2 February 2009, the examiner mailed to applicants a first non-final Office action in which the examiner indicated that the traversal was considered, and the requirement was made FINAL. The examiner withdrew claims 6 and 14-29 from consideration. Claims 1-5, 7-11 and 30-38 were objected to for reciting non-elected subject matter. Claim 1-5, 7-11 and 30-38 was rejected under 35 U.S.C. 112, first paragraph for lack of written description and for scope of enablement. Claim 1-5, 7-11 and 30-38 was rejected under 35 U.S.C. 112, second paragraph for

indefiniteness. Claims 1-7 and 30-38 were rejected under 35 U.S.C. 102(b) as being anticipated by Reckhow. Claims 1-5, 7, 9-10, 30-38 were provisionally rejected on the groups of nonstatutory double patenting over pending application 12/328,320. Claims 1-5, 7, 9-11, 30-38 were rejected on the groups of nonstatutory double patenting over 7,470,702.

On 20 July 2009, applicants filed a response to the Office action.

On 7 December 2009, the examiner mailed to applicants a final Office action in which claims 6 and 14-29 remained withdrawn from consideration. Claims 1-5, 7-11 and 30-38 were objected to for reciting non-elected subject matter. The examiner indicated that Claims 4, 7, 8, 10, 11 and 38 were objected to for being dependent upon a rejected base claim, but would not necessarily be allowable if rewritten in independent form. Claims 1-3, 5, 9, and 30-37 were rejected under 35 U.S.C. 102(b) as being anticipated by Garin et al.

A Request for Continued Examination was filed on 8 March 2010.

On 12 April 2010, the examiner mailed to applicants a non-final Office action in which claims 6 and 14-29 remained withdrawn from consideration. Claims 1-5, 7-11 and 30-38 were objected to for reciting non-elected subject matter. The examiner indicated that Claims 2, 8 and 38 were objected to for being dependent upon a rejected base claim, but would not necessarily be allowable if rewritten in independent form. Claims 1-3, 5, 9, 10 and 30-37 were rejected under 35 U.S.C. 102(b) as being anticipated by Renhowe et al. Claim 11 was rejected under 35 U.S.C. 103(a) as being unpatentable over Renhowe in view of 6,579,857.

On 12 July 2010, applicants filed a response to the Office action.

On 9 September 2010, the examiner mailed to applicants a final Office action in which claims 6 and 14-29 remained withdrawn from consideration. Claims 1, 3, 5, 7-11 and 30-38 were objected to for reciting non-elected subject matter. The examiner indicated that Claim 8 was objected to for being dependent upon a rejected base claim, but would not necessarily be allowable if rewritten in independent form. Claims 1, 3, 5, 9, 10 and 30-37 were rejected under 35 U.S.C. 102(b) as being anticipated by Renhowe et al. Claims 1, 3, 5, 9, 10 and 30-35 were rejected under 35 U.S.C. 102(b) as being anticipated by El-Gaby et al. Claim 11 was rejected under 35 U.S.C. 103(a) as being unpatentable over Renhowe in view of 6,579,857.

On 9 December 2010, applicants filed this petition.

A Request for Continued Examination was filed on 3 January 2011.

## **DISCUSSION**

The file history and petition have been considered carefully.

The petition requests examination on the entire scope of compound claim 1 (Group I and II) and that the methods of using the compounds (Group III and IV) be examined with the compound claims. These requests are persuasive in part.

First, concerning the propriety of the intra-claim restriction required between Group I and Group II, in February 2011, the Office issued a Federal Register Notice entitled “Supplemental Examination Guidelines for Determining Compliance with 35 U.S.C. 112 and for treatment of Related Issues in Patent Applications.” Page 7166 sets forth guidelines for the treatment of Markush-type claims:

“Under principles of compact prosecution, the examiner should also require the applicant to elect a species or group of indistinct species for search and examination (i.e., an election of species). If the examiner does not find the species or group of indistinct species in the prior art, then the examiner should extend the search to those additional species that fall within the scope of a permissible Markush claim. In other words, the examiner should extend the search to the species that share a single structural similarity and a common use. The improper Markush claim should be examined for patentability over the prior art with respect to the elected species or group of indistinct species, as well as the species that share a single structural similarity and a common use with the elected species or group of indistinct species (i.e., the species that would fall within the scope of a proper Markush claim).”

In view of these new guidelines, the restriction between Group I and II is withdrawn and re-formatted as a provisional election of species requirement. Similarly the restriction requirement between Group III and IV is withdrawn and re-formatted as a provisional election of species requirement. Elected Group I and species of example 3 will continue to be examined in a manner consistent to the Federal Register Notice.

Concerning the restriction required between the product and process, ISPE Guidelines provides the following example directed to this situation:

#### 10.21 Example 1

Claim 1: A method of manufacturing chemical substance X.

Claim 2: Substance X.

Claim 3: The (method of) use of substance X as an insecticide.

Unity exists between claims 1, 2 and 3. The special technical feature common to all the claims is substance X. However, if substance X is known in the art, unity would be lacking because there would not be a special technical feature common to all the claims.

In this example, product claim 2, directed to Substance X is identified as being the shared technical feature. In this instant application, the compounds of Group I are considered to be the shared technical feature. The method of using the compound (claim 3 of the Example) is comparable to this application’s Groups (III and IV) method of using the compound. In keeping

with this example, the examiner here has determine that the technical feature (the product) does not make a contribution over the prior art, as evidenced by the outstanding prior art rejections.

For this reason, unity remains lacking between the product (rejoined Groups I and II) and the process (rejoined Groups III and IV).

## **DECISION**

The petition filed under 37 CFR 1.181 on 10 June 2011 is **GRANTED-IN-PART** follows.

The restriction required between Groups I and II has been withdrawn and is replaced with an election of species requirement.

The restriction requirement set forth between Group III and IV has been withdrawn.

The restriction requirement between the products (Groups I and II, now rejoined) and the processes (Group III and IV, now rejoined) is maintained in view of the fact that a prior art rejection is pending upon the product claims. Should all claims to the product become allowable, the examiner will consider the process claims for rejoinder according to the practice set forth in MPEP 821.04(b).

The objection to Claims 1-5, 7-11 and 30-38 for reciting non-elected subject matter has been withdrawn. The objection to Claims 4, 7, 8, 10, 11 and 38 for being dependent upon a rejected base claim, but would not necessarily be allowable if rewritten in independent form is withdrawn. Markush claims will be examined according to the procedures set for in the February 2011 Federal Register Notice.

**The application will be forwarded to the examiner to consider the papers filed 3 January 2011, and to prepare an Office action consistent with this petition decision.**

**Any request for reconsideration of this petition decision should be filed under 37 CFR 1.181 with two months of the mail date of this decision.**

Should there be any questions regarding this decision, please contact Quality Assurance Specialist Julie Burke by mail addressed to Director, Technology Center 1600, PO BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at (571) 272-0512 or by Official Fax at 703-272-8300.



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